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| In re Application of | : | OFFICE OF PETITIONS |
| Marisetty, et al. | : | |
| Application No. 10/628,769 | : | DECISION ON PETITION UNDER |
| Filed: July 28, 2003 | : | 37 C.F.R. §1.59(b) |
| Attorney Docket Number: | : | |
| 042390.P7649C | : | |

This is a decision on the petition filed March 3, 2009, pursuant to 37 C.F.R. §1.59(b), requesting that the issue fee payment made January 23, 2009, be expunged1.

The petition is **DISMISSED**.

A review of the application file history reveals that a Notice of Allowance and Issue Fee Due was mailed October 21, 2008, requiring payment of the issue fee and allowing a statutory period for reply of three months from its mailing date. The issue fee payment was made on January 23, 2009. It is noted than Request for Continued Examination was filed on January 21, 2009. It appears that the application is proceeding under Request for Continued Examination as a non-final Office action was mailed on March 3, 2009.

37 C.F.R. §1.59 sets forth:

§ 1.59 Expungement of information or copy of papers in application file.

(a)

- (1) Information in an application will not be expunged, except as provided in paragraph (b) of this section.
- (2) Information forming part of the original disclosure (i.e., written specification including the claims, drawings, and any preliminary amendment

1 It is assumed that applicant is request expungement of the issue fee transmittal form filed January 23, 2009. If petitioner is requesting refund of the issue fee payment, this request must be made through the Office of Finance, Office of Refund under 37 CFR 1.26.

specifically incorporated into an executed oath or declaration under §§ 1.63 and 1.175) will not be expunged from the application file.

(b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(h) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

(c) Upon request by an applicant and payment of the fee specified in § 1.19(b), the Office will furnish copies of an application, unless the application has been disposed of (see §§ 1.53(e), (f) and (g)). The Office cannot provide or certify copies of an application that has been disposed of.

[48 FR 2710, Jan. 20, 1983, effective Feb. 27, 1983; 49 FR 554, Jan. 4, 1984, effective Apr. 1, 1984; 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; 50 FR 23123, May 31, 1985, effective Feb. 11, 1985; revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (b) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (b) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; revised, 68 FR 38611, June 30, 2003, effective July 30, 2003]

In deciding the petition to expunge information from an application, Section 724.05 of the *Manual of Patent Examining Procedure* provides, in pertinent part, that:

A petition to expunge information unintentionally submitted in an application (other than information forming part of the original disclosure) may be filed under 37 CFR 1.59(b), provided that:

- (A) the Office can effect such return prior to the issuance of any patent on the application in issue;
- (B) it is stated that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted;
- (C) the information has not otherwise been made public;
- (D) there is a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted;
- (E) it is established to the satisfaction of the Director that the information to be returned is not material information under 37 CFR 1.56; and
- (F) the petition fee as set forth in 37 CFR 1.17(*>g<) is included.

The instant petition does not satisfy (B) above. It is further noted that the petition to expunge is not the appropriate if petitioner is seeking to obtain a refund of the issue fee paid. A request for refund of the issue fee should be filed under 37 CFR 1.26 and directed to the Office of Finance, Office of Refund.

The renewed petition must provide appropriate statement as to item (B).

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3222.

/Kenya A. McLaughlin/

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